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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,142	11/12/2003	Roger W. Phillips	48930-01703	6069

27975 7590 01/17/2007
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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/706,142

Applicant(s)

PHILLIPS ET AL.

Examiner

Mathieu D. Vargot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/28 & 12/19/06</u> | 6) <input type="checkbox"/> Other: _____ |

1.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al for reasons of record.

In particular, Uyama et al discloses the basic claimed method lacking essentially—

1) that the optical interference pattern--ie, diffraction grating or holographic image—and the color shifting optical coating are formed on opposite surfaces of the substrate and
2) that the security article is necessarily hot-stamped to an object. The first aspect has already been discussed and is submitted to be an obvious variant over providing both on the same side of the substrate as shown in Uyama et al. Concerning the second, the reference provides an adhesive layer by which the security laminate would be attached to an object. It certainly is well known in the art to hot stamp or press such a laminate to an object and such would have been an obvious feature over using an adhesive layer.

2.Claims 3 and 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al in view of Coombs et al –530 for reasons of record.

3.Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al in view of the admitted prior art for reasons of record, the admitted prior art showing the use of color shifting inks with flakes in a polymer medium. These would have been obvious selections for the color layer 12 disclosed in Uyama et al.

4. Applicant's arguments filed October 31, 2006 have been fully considered but they are not persuasive. Applicant has provided arguments and a declaration as evidence that the instant claims are patentable over Uyama et al. However, these are not persuasive. First of all, it is respectfully submitted that the placement of the color shifting layer with respect to the interference pattern would have no bearing on the appearance of the color shift property and that of the security article. Concerning this, the examiner's rationale given in the Final Rejection of case serial number 10/705,610, paragraphs 7 and 8, is hereby made of record. To wit, the examiner stated that it made no difference in Uyama et al whether the light is transmitted or reflected through the color shift coating, since the reference teaches that the color shift will be observed for either—see column 6, lines 1-11 and 25-34 of Uyama et al. Since the substrate is transparent, it would not affect the color shifting property of the color shifting layer. Applicant should note, as pointed out in the aforementioned final, that the light path for the instant application and that for Uyama et al are as follows:

Instant: Incident light—Interference pattern—Substrate—Color Shift coating

Uyama et al: Incident light—Substrate—Interference pattern—Color Shift coating

Unless the substrate has some optical property in either the instant or in Uyama et al—and nothing is disclosed of such property, as the substrates are said to be transparent—the incident light clearly undergoes the same path and would therefore be subjected to the same effects due to the optical effects of the layers.

Concerning the declaration, the Exhibit noted by Garth Zambory as showing some unexpected results did not accompany the declaration and hence it is not probative. Also, it would appear that the declaration is primarily stating conclusions and not facts that would show any unexpected results. Mr. Zambory suggest that the light transmissive substrate serves to "decouple" the instant effects while those of Uyama et al would "always occur together simultaneously" due to the placements of the layers. As pointed out above, it is respectfully not seen how this can be so since the substrates are transmissive with respect to light. Comments in the penultimate paragraph of the declaration are not relevant and those in the last paragraph constitute conclusions , not facts.

5.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

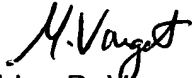
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
January 7, 2007


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

1/7/07